

Remarks

Favorable reconsideration of this application is requested in view of the following remarks. For the reasons set forth below, Applicant respectfully submits that the claimed invention is allowable over the cited references.

The Office Action dated June 6, 2005, indicated that claims 1-26 are rejected under 35 U.S.C. § 103(a) over Ginter *et al.* (U.S. Pat. No. 5,982,891) in view of Mandler *et al.* (U.S. Patent No. 5,732,400).

In an effort to facilitate prosecution, Applicant has reduced the number of claims by canceling claims 1-12 without prejudice and reserves the opportunity to pursue the canceled subject matter in a continuing application.

Applicant again respectfully requests that the Office Action Response and Amendment filed on July 9, 2003, be reviewed and, in view thereof, that the Examiner enter and address claim 27, which was added in the Office Action Response and Amendment of July 9, 2003.

According to the law, a §103(a) rejection cannot be maintained without considering all the limitations in the claim as well as the invention “as a whole.” Applicant respectfully submits that the instant rejections ignore important claim limitations and, therefore, fails to consider the claimed invention “as a whole.” Applicant also respectfully submits that the supporting rationale provided in the Office Action is based on mere conjecture that the proposed modification would achieve a result (*e.g.*, ensure proper determination of whether to not to authorize a specific transaction). No evidence from either of the cited references has been identified as suggesting the proposed modification and, as is further discussed below, such a modification contradicts the teaching of the cited prior art. Without a presentation of evidence of either correspondence or motivation to combine the cited references, the Section 103(a) rejection cannot stand.

Turning first to the rejections of independent claims 13, 23 and 26, contrary to the Office Action’s overview of the prior art (*i.e.*, the ‘891 reference as modified by the ‘400 reference), this asserted prior art does not correspond to the claimed invention. The Office Action does not cite any aspect of either reference that relates to the claimed limitations of “... determining whether the transaction information satisfies the

authorized profile list criterion” The Office Action’s reliance upon the ‘891 reference at column 282, line 16 – column 284, line 15, as teaching the claimed “...determining whether the transaction information satisfies the authorized profile list criterion” is misplaced. A review of this relied upon portion fails to reveal any discussion of such determination of an authorized profile list criterion being satisfied.

Further, the asserted combination of these teachings (the ‘891 reference as modified by the ‘400 reference) lack motivation. The Office Action fails to identify any evidence in support of the motivation, and such supporting evidence is required in order to sustain the argument that the skilled artisan would modify the relied-upon embodiment of the ‘891 reference with the cited teaching of the ‘400 reference. Moreover, the Office Action’s argument that the skilled artisan would be so led to modify this embodiment of the ‘891 reference assumes that, without such modification, this ‘891 embodiment would not “ensure proper determination of whether to not to authorize a specific transaction.” However, according to the ‘891 reference, this relied-upon embodiment (without modification via such teachings of the ‘400 reference) already teaches how to “help to ensure that information is accessed and used only in authorized ways, and maintain the integrity....” (abstract), and teaches that the object of this embodiment is to “provide[s] a new kind of ‘virtual distribution environment’ ... that secures, administers and audits electronic information use” (column 2, lines 22-25). Thus, the alleged motivation for modifying the ‘891 reference contradicts the reference’s express teaching and purpose.

Applicant further submits that this alleged motivation for modifying the ‘891 reference violates a basic tenet of the law under §103: a §103 rejection cannot be maintained when the asserted modification undermines purpose or operation of the main reference. To so modify the ‘891 reference with the teachings from the ‘400 reference would result in an entirely different way in which the ‘891 reference’s ‘virtual distribution environment’ would secure, administer and audit electronic information use. Further, such a modification of the ‘891 reference is tantamount to mixing teachings out of context. Such a rejection is not permissible under § 103. *See also In re Kotzab*, 217 F.3d 1365 (Fed. Cir. 2000) (proposed modification must not be made in the abstract but rather made in view of the entire teaching of the prior art).

Applicant also traverses the rejections of claims 14 and 15. As with the above-discussed claim rejections, the rejections of claims 14 and 15 also fail to consider each of the claimed limitations and, therefore, the claimed invention when considered “as a whole.” Each of claims 14 and 15 include limitations directed to structure “for indicating when the account for the vendor should be debited, and for indicating when payment to the merchant-offering provider and subvendor should be tendered, and for notifying a financial institution the cost of service”(e.g., as in claim 14). The Office Action relies upon the ‘891 reference at column 282, line 16 – column 284, line 15, as teaching this claimed functionality. However, a review of this relied upon portion, as well as the entire teaching of the ‘891 reference, fails to reveal any discussion of this functionality. Applicant requests that this §103 rejection also be withdrawn for lack of correspondence.

Moreover, Applicant submits that this §103 rejection should also be withdrawn for lack of any evidence of motivation. In view of the law discussed above and a lack of any cited evidence to support the notion that a skilled artisan would (need to) make the change, Applicant submits that the above-presented arguments and law also apply to this rejection.

Turning now to claims 16-26, the Office Action asserts that these claims correspond to the same inventive concept as set forth in claims 1-15. However, claims 16-26 include several limitations not found in claims 1-15. For example, claims 16-22 include limitations directed to use of business rules defined according to authorized profile list criterion. Other limitations that have been ignored by the Office Action include: multiple levels of authorization (claim 17), two different payment-authorization levels (claim 18), a central processing arrangement programmed and configured to provide correspondence between at least one of the levels of authorization to a requested transaction (claim 19), a processor that determines whether the processed transaction information satisfies the authorized profile list criterion (claim 23), using the authorized profile list criterion to generate information for auditing (claim 24), and determining whether the remotely processed transaction information satisfies the authorized profile list criterion (claim 26). In view of the above, Applicant respectfully traverses the Section 103(a) rejections.

Applicant accordingly requests that the rejections be withdrawn.

In view of the remarks above, Applicant believes that the rejection has been overcome and the application is in condition for allowance. Should there be any remaining issues that could be readily addressed over the telephone, the Examiner is encouraged to contact the undersigned at (651) 686-6633.

Respectfully submitted,

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